

REMARKS

Claims 1, 7 – 10, 12 – 18, 20 – 22, and 24 – 27 are pending in the present Application. Claims 14 and 15 have been withdrawn from consideration. Claim 25 has been canceled, and new Claims 28 – 37 have been added, leaving Claims 1, 7 – 10, 12 – 13, 16 – 18, 20 – 22, 24, and 27 – 37 for consideration upon entry of the present Amendment.

Reconsideration and allowance of the claims are respectfully requested in view of the following remarks.

Objected-to Claim 25 and New Claims 27 – 36

The Applicants thank the Examiner for the statement that Claim 25 would be allowable if rewritten in independent form. Office Action dated 01/24/2008, p. 7. Accordingly, Claim 25 has been cancelled, and rewritten in independent form as new claim 27, incorporating the limitations of Claims 1 and 25. No new matter has been introduced by this amendment.

New claims 28 – 36 have been added to depend from claim 27. Each of these new claims finds antecedent basis in one of pending Claims 7 – 10, 12 – 13, 20, and 26 – 27. It is believed that each of these claims is also allowable, as they depend from an allowable independent claim.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1, 7 – 10, 12, 16 – 18, 22, 24, and 26 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent Publication No. 2004/0154264 to Colbert (Colbert) in view of U.S. Patent Publication No. 2004/0142115 to Jaworek et al. (Jaworek) and U.S. Patent No. 6,610,760 to Eckberg et al. (Eckberg).

Claims 13 and 27 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Colbert in view of Jaworek and Eckberg as applied to claim 1, and further in view of U.S. Patent Publication No. 2003/0203191 to Randall et al. (Randall).

Claims 20 and 21 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Colbert in view of Jaworek and Eckberg as applied to claim 1, and further in view of U.S. Patent No. 6,162,511 to Garnett et al. (Garnett).

Applicants respectfully traverse these rejections.

Regarding the newly added limitation in claims 1 and 16 that “the radiation curable composition is essentially free of water,” the Examiner states that Colbert discloses in paragraphs [0035] and [0086-0092] that water is added up to 100%. The Examiner further states that “using the percentages of mineral filler, perlite, binder, handling agent, and two types of slipping agents taught by Colbert, the composition would be considered essentially free of water”. Office Action dated 01/24/2008, p. 3.

Applicants respectfully assert that one of ordinary skill in the art, reading Colbert as a whole, would understand that Colbert teaches that the coating compositions used to make the gypsum boards are not “essentially free of water.”

In particular, Colbert teaches that a coating is applied to a wet gypsum board at paragraph [0014]. Colbert further teaches that in “one exemplary embodiment, the coating has a composition of 25-75 vol. % water”. Paragraph [0015]. In another embodiment, the coating composition has 10-60 vol. % water. Paragraph [0016]. Colbert further teaches an embodiment having “a coating that hardens by evaporation of the water content” using a coating that comprises a water content of 35-45 wt. %. Paragraph [0057]. Colbert also teaches dilution “by the addition of water.” Colbert p. 5, ¶0057. None of these embodiments could be said to be essentially free of water.

The Examiner appears to be referring to a specific embodiment wherein the coating composition is a joint compound or a diluted joint compound (paragraph [0016]). A “joint-pointing coat according to the invention” comprises, among other constituents, 2 to 12% by weight of a binder comprising “polyvinylacetates and acrylic acid esters in aqueous dispersion” Paragraph [0035]. Other jointing materials can have 0.1 to 10% by weight of a binder in aqueous solution, wherein water is added with conventional additives up to 100%.” Paragraphs [0085-0092]. Theoretically, if large amounts of mineral filler, hydrophobic surface perlite, and handling agents were used, the amount of water in these joint compounds could be very small.

However, as is known to those of ordinary skill in the art, use of such small amounts of water would result in compositions that could not be coated. Note that all of the components of the formulation disclosed at paragraphs [0085-0092] are solids. While it may be possible to individually use the various solid components in amounts at the upper end of the recited ranges,

use of all of the solid components in such large amounts as to result in a composition having “essentially no water” would result in a composition that could not be coated. Thus, one of ordinary skill in the art would not view Colbert as teaching compositions having “essentially no water” – such compositions would be of no utility.

As support for this proposition, note that paragraph [0083] discusses the relative amounts of water in skim coats versus the jointing material. It is stated that the skim coat “will comprise more water than initially present in the jointing material”. It is then stated that “By ‘water initially present in the jointing material’, it means the amount of water present in the jointing material when the jointing material is applied to the skim coated prefabricated elements, before the jointing material is in the dry state.” (Emphasis added). In order for the jointing material to have a “dry state”, it must have initially had a “wet state”, i.e., a state with more than “essentially no water.” One of ordinary skill in the art would therefor understand that Colbert teaches use of water in its coating compositions.

The Examiner also admits Colbert does not disclose that the coating is a radiation curable coating formulation, but asserts Jaworek discloses a coating cured by high energy radiation and that it would have been obvious to have used Jaworek’s method of radiation curing in the coating of Colbert. Office Action dated 01/24/2008, p. 3. Because Colbert teaches an aqueous coating composition, one of ordinary skill in the art would not have had a reasonable expectation of success combining it with the compositions taught by Jaworek or Eckberg. Neither Jaworek nor Eckberg teach compositions that are predictably operable in an aqueous solution. Because Colbert teaches an aqueous composition, and Jaworek and Eckberg teach a non-aqueous composition, one of ordinary skill in the art would not have had a reasonable expectation of success in the suggested combination.

Thus Colbert in view of Jaworek and Eckberg do not establish a *prima facie* obviousness at least because the references fail to provide a reasonable expectation of success. Randall and Garnett do not remedy the deficiencies of these references. Therefore Claims 1 and 16 are patentable over Colbert, Jaworek, and Eckberg. Claims 7-10, 12, 13, 17-18, 20-22, 24, and 26-27 depend directly or indirectly from Claims 1 or 16, thus are also patentable for at least these reasons.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and withdrawal of the objection(s) and rejection(s) and allowance of the case are respectfully requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

CANTOR COLBURN LLP

By____/Leah M. Reimer/_____
Leah M. Reimer
Registration No. 39,341

Date: April 24, 2008
CANTOR COLBURN LLP
20 Church Street
22nd Floor
Hartford, CT 06103-3207
Telephone: (860) 286-2929
Facsimile: (860) 286-0115
Customer No.: 23413